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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial Number: 09/849,315 Atty Docket 4025

Filing Date: May 7, 2001 Art Unit 1772

Inventor: Joseph J. Solon Examiner Alexander S. Thomas

For: Environmentally Safe Method and Apparatus for Storage of Discarded Tire Rubber

BRIEF ON APPEAL

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CITATIONS OF CASE LAW AND AUTHORITIES

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BRIEF ON APPEAL

To The Commissioner of Patents and Trademarks,

Sir:

Three copies of this brief are presented timely within two months after timely filing of appeal on January 22, 2003 with the $160.00 small business appeal brief fee under 1.17(c).

(1) Real party in interest

The real party in interest is the assignee of record –Interstate Recycling Corp. 107 South Street, Auburn, NY 13021.

(2)Related appeals and interferences

None.

(3) Status of claims

Retained Claims 1, 2, 9-11, 13 and 15 are rejected in the final rejection of Oct. 30, 2002 under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Pignataro ('083). The first 35 U.S.C. 103(a) rejection of Claims 1, 9 and 14 is made in the final rejection, and thus applicant was given no chance for traversal before the final rejection.

Claims 3-8, 12 and 16 are objected to as depending upon a rejected base claim but were indicated allowable in the Final Rejection of Oct. 30, 2002 if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims were rewritten in independent form in the first response after final rejection filed Dec. 9, 2002 but objection to these claims is nevertheless continued in the advisory action of Jan 8, 2003.

(4) Status of amendments

Two responses amending the claims filed after Final rejection are entered for purpose of appeal, with the Examiner's refusal to consider the accompanying *Declaration under 37 CFR 1.132 traversing the Examiner's rejection grounds.*

Retained claims rejected under 35 U.S.C. 103(a) are claims 1, 2, 9-11,13, and 15, and the claims objected to 3-8, 12 and 16 have been put into independent form with the limitations of preceding main and intervening claims, but nevertheless still stand rejected as objected to in the latest advisory action of Jan. 8, 2003.

(5) Summary of the invention

This invention comprises methods of storing and handling batches of flat rubber tire treads *excluding the sidewalls,* which are cut from discarded tire carcasses and stacked on pallet platforms in compact rubber-to-rubber interfacing configuration eliminating voids for accumulating water in mosquito breeding sites and providing frictional resistance against relative lateral movement of individual tire treads stacked on the pallet loading platforms during transportation. The bulk storage capacity of reusable

tire tread rubber is unexpectedly increased many fold over prior art by covering substantially all of the pallet loading platform with the flat tire tread section stacks. The loaded pallets when pyramided in self supporting relationship upon each other with fork lift trucks significantly reduce the required area taken for storage of reclaimable tire carcass rubber in outside bulk storage sites. The flat tread strips in some embodiments are folded over in interlocked layers for even more stability to undergo transportation upon the pallet platforms to eliminate the need for external binding straps retaining the tire tread strips in bundles on the pallet platforms during transportation.

This invention has the unexpected advantages over prior art bulk storage methods for reclaimable tire tread rubber of (a) avoiding internal cavities that gather water producing mosquito breeding sites when stored in an outside environment, (b) unexpectedly larger densely packed bulk quantities of tire tread strips (excluding sidewalls) in compact stacks on pallet bulk storage units, and (c) stable in-place transportation on fork lift trucks withstanding vibration and handling without requiring external fasteners such as straps binding the stacks in bundles (Miller).

The Examiner in his first action of Aug. 29, 2002 concedes that Miller does not disclose removing the sidewalls from the tread, completely filling the pallet, storing the pallets outdoors or storing the pallets side-by-side and upon one another.

6) Issues

(a) The Examiner errs as a matter of oversight in objecting to claims 3-8, 12 and 16 rather than allowing them after being put into independent form with the foregoing

parent claims;

(b) The Examiner errs in rejecting retained claims 1, 2, 9-11,13 and 15 under 35 U.S.C. 103(a).

More specifically the Examiner fails to establish a prima-facie case of obviousness over the claimed invention, and misinterprets the scope and teachings of the cited references. In this respect the Examiner errs in his interpretation that the Miller Reference bundles *form a generally solid form and therefore would inherently prevent the accumulation of water,* and fails to establish the obviousness of Miller in removal of binding straps required to keep the tread-sidewall mats in the unnatural flat condition for transport in bundles.

Furthermore, the Examiner errs in rejecting retained Claims 1 and 9 under 35 U.S.C. 103(a) for the first time in the final rejection without the opportunity for prior traversal.

(c) The Examiner errs in failing to consider the Declaration under 37CFR 1.132 traversing the Examiner's rejection grounds, and in not stating that it is entered for purpose of appeal, particularly in view of the first (103) rejection of Claims 1 and 9, and the Examiner's first rejection on the issue that Miller inherently prevents accumulation of water is in the final rejection.

Note that the 35 U.S.C. 102(b) rejection of claims 1 and 9, which were only rejected as anticipated by Miller, which rejection was withdrawn in view of applicant's amendment to Claim 1 that the tire treads excluded the Miller sidewalls.

(7) Grouping of claims

The claims do not stand or fall together as a group, but are believed to be separately patentable as novel interacting combinations of elements affording different objectives.

(8) (iv), (v) Argument

(8)(iv) **THE 35 U.S.C. 103(A) REJECTION GROUNDS**

I. BACKGROUND

A. THE REFERENCES APPLIED UNDER 35 USC 103 (a)

Retained claims 1, 2, 9-11 and 13 and 15 are rejected as being unpatentable as obvious over Miller in view of Pignataro (083).

Miller 5,472,750 teaches a construction element generally shown in Fig. 4 as a bale of flattened cut up tire carcass mats, namely the tire tread 13 with attached sidewall portion 20, stacked and bound together by straps 42 required since the the entire carcass with tire tread 13 attached to the sidewall 20 (col. 3, lines 43-46) cannot naturally lie flat, after vulcanization and residual memory biasses the sidewall and tread to remain at substantial right angles. The flat mats are stacked tightly upon one another and secured into a bale to form a *nearly solid block* (Col 4, lines 57–60) that is misrepresented in Figs. 4-6 by leaving out the structure showing different thicknesses of the tread and sidewall portions, which inherently includes void spaces between adjacent mats in the transition areas merging the thicker treads into the thinner sidewalls, which void spaces

have the propensity of accumulating water puddles that breed mosquitos when stored in the outside environment. Since each flattened mat has a thicker tread portion 13 and a thinner sidewall portion 20 (col. 7, lines 23-26) Fig. 4 is misrepresentative in that the outer ends of the thinner bundled sidewalls cannot achieve the same accumulated thickness as that of the centered thicker tread portions as shown in Fig. 4.

Also note in col. 7, 50-53 that Miller requires that these strapped together bundles must be further strapped together in larger bundles for palletizing and handling with fork lift trucks.

The invention of Miller as expressed in the parent Claim 1 requires that *each said flexible mat is generally rectangular and is formed from an entire used tire casing having a series of slits in the sidewalls.*

The Examiner concedes in the first action of Aug 29, 2002 that Miller does not disclose completely filling the pallet, storing the pallets outdoors or storing the pallets side by side and upon one another, but never shows how Pignataro teaches to modify these Miller deficiencies to establish applicant's claimed combinations.

The Miller construction element would be taken out of context and therefore must be considered inoperable if formed from flat tread strips *without sidewalls*, a feature explicitly defined in each of applicant's claims rejected under 35 U.S.C. 103(a).

Pignataro 5,834,083 teaches that two used tire tread strips must be *bonded face-to-face*, (Claim 1) on the non-tread side to form two-ply strips (42 Figs. 10, 14 & 18), which

are bolted together in groups to form construction components (col 2, lines 24-34).

There is no concept taught here of storing flat tread strips on pallets, nor of piling tread strips singly in compact rubber-to-rubber interfacing configurations with frictional resistance between the tread strips impeding lateral movement of individual tire tread sections relevant to each while transported on a pallet platform as claimed by applicant. Note conversely that the piles of strips in Pignataro are bolted together in the stacks to form construction elements, and has no objective of storage of bulk rubber for later reclamation as claimed by applicant.

There is no teaching in this reference of any manner of modification of Miller's configurations to remove Miller's sidewalls or to make bundles of mat layers not bonded together by straps for transportation on pallets. That is taught only by reference to applicant's disclosure, and therefore is not obvious under 35 U.S.C. 103(a).

B. STATUS OF APPLICABLE 35 U.S.C. 103 CASE LAW

The Examiner's burden of proof.

In proceedings before the Patent and Office, the examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki,* 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art *would lead* that individual to combine the relevant teachings of the references. *In re Fine, 837 F.2d 1071,*

1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Indeed the teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital, 723 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed, Cir. 1984).*---Ex Parte Obukowicz, 27 USPQ2d 1063, 1065 (PTO BA).

See also *In re Oetiker*, 24 USPQ2d 1443, 1444 for a review of the duty of the Examiner to establish a *prima facie* case of obviousness.

The Examiner herein has failed to establish a *prima facie* case herein not pointing out how Pignataro leads one of ordinary skill in the art to combine the relevant teachings of the references for each of the claims 1, 2, 9-11, 13 and 15 or the incentive of Pignataro to do so, and therefore fails to fulfil his burden of proof. It is clear that he has not pointed out any teachings for changing the construction product of the references to an outside bulk storage system with flat tire tread sections excluding the sidewalls required by Miller, nor with stacks of treads not secured in back to back treads bonded together.

<u>It is reversible error by the Examiner to apply one reference to a second in a manner that would render the second reference inoperative.</u>

Since the Examiner applies Pignataro to Miller as an unexplained or pointed out teaching that the integral Miller sidewalls are obviously exchangeable with tire tread strips without sidewalls, that reasoning is not within the scope of the 35 U.S.C. 103(a) obviousness as now set forth:

> –if the *teachings* of a prior art reference would lead one skilled in the art to make a modification which would render another prior art device inoperable, then such a modification would generally not be obvious. *See In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). —In re Kramer, 18 USPQ2d 1415 (Fed. Cir. 1991).

The entire nature of the construction products sought for and achieved in Miller

would be changed and have no basis without unobviously changing the entire Miller disclosure under the provisions of this case law.

II. THE MERITS OF THE CLAIMS

A. CLAIMED LIMITATIONS NOT TAUGHT IN THE CITED ART

Claim 1 is parent to the remaining rejected claims 2, 9-11, 13 and 15, and thus is reproduced and primarily discussed since the unobviousness of Claim 1 will establish unobviousness of all the remaining rejected claims. The novel features are emphasized in italics.

Claim 1. The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses ***in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products***, comprising in combination the steps of: cutting reclaimed tire carcasses into sets of substantially ***flat storable sections of tire tread strips excluding sidewalls***, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, and ***stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area*** thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space.

Both references have the objective of preparing construction elements, and not the method of storing bulk rubber more effectively at bulk storage sites for later reclamation, and particularly in outdoor sites where prior art tire storage systems develop mosquito

breeding puddles in the prior art. The elimination of mosquito breeding grounds in outside bulk storage sites for reclaimable tire rubber is a significant objective of the invention and is not achieved by either cited reference.

The bundling and storage of flat tire tread strips excluding sidewalls for outdoor bulk storage sites is a novel feature. Note the contrast to Miller who cuts tires at the outdoor storage sites and does not store the bundled mats there but takes them elsewhere.

The ***compact rubber-to-rubber interfacing configuration*** with frictional resistance to avoid lateral displacement is contrary to Miller which requires binding the mats together to prevent lateral displacement of flattened mats while in transport. The nature of the Miller "flattened mats" having sidewalls integral with treads could not remain in flattened condition because of vulcanization in the manufacturing stage to mold and retain the treads and sidewalls virtually at right angles, and the memory retained. Thus, the flattened sidewalls of Miller require bonding straps, and are not in any way equivalent to the flat tire tread sections of applicant that have the propensity to lie flat.

Accordingly the interacting combination of Claim 1 with its novel configurations and outside bulk storage features is unique and different from both references, which emphasizes that the Examiner did not exercise his duty to provide a prima-facie case of obviousness. Hindsight thus was afforded the Examiner only by applicants claimed disclosure for applying references in the discarded tire arts having different objectives and disclosing different features than the claimed combinations of applicant. That is not obviousness under 35 U.S.C. 103(a).

Note in particular that the compact rubber-to-rubber interfacing feature of tire tread sections not having integral sidewalls provides a system that inherently does not accumulate water puddles in outdoor storage sites, which is discussed in more detail hereinafter.

III. EXPLICIT REJECTIONS OF THE REJECTED CLAIMS

CLAIMS 1 AND 9 were rejected solely under 35 U,S.C. 102(b) in the initial office action. This rejection ground was dropped in the next office action, the final rejection after applicant's amendment of parent Claim 1 to flat tire tread strip sections *exclusive of sidewalls.* These claims now are rejected in a general grouping of claims under 35 U.S.C. 103(a) for the first time in the final rejection, which applicant had not had the opportunity to traverse.

The Examiner concedes that the primary reference Miller does not disclose removing the sidewalls. In his rejection ground he states:

The secondary reference discloses removing the sidewalls from the tread prior to shipping in a recycling process. (Applicant in Fig. 1 concedes that this is prior art.) It would have been obvious to one of ordinary skill in the art to remove the sidewalls from the tread as taught by the secondary reference in the process of the primary reference if extra processing steps and expense could be tolerated and depending on the desired final article that is to be made. — Applicant also argues that Miller does not disclose the method step of preventing the accumulation of water in the strips. However, Miller clearly discloses stacking the mats to form a generally solid form and therefore would inherently prevent the accumulation of water; —

As hereinbefore set forth Claim 1 has several novel and material limitations not found in Miller including the bulk storage feature not found in either reference, and the compact rubber-to-rubber interfacing configurations of flat tread sections exclusive of

sidewalls for producing frictional resistance against relative lateral movement of each of the individual tread sections during transport in bulk on filled pallet platforms by a fork lift truck. Miller teaches that if more bundles are to be transported the Miller bundles need to be bound together by further straps, col. 7, lines 50-53. This is a further teaching contrary to applicants bulk storage and transportation of treads without sidewalls on pallet platforms. The Examiner has conceded that Miller does not teach completely filling the pallet, storing the pallets outdoors, or storing the pallets side by side and upon one another. Thus, the Examiner has not exercised his burden of proof in establishing obviousness of Miller in producing the claimed inexpensive compact bulk storage of tire tread rubber at storage sites as defined in Parent Claim 1.

Claim 9 The method of Claim 1 further comprising the step of piling said flat sections into stacks that avoid accumulation of water when stored outside in the environment.

The Examiner for the first time in the final rejection rejects Claim 9 on 35 U.S.C. 103(a) on the basis: "Applicant also argues that Miller does not disclose the method step of preventing accumulation of water in the strips. However, Miller clearly discloses stacking the tire mats to form a generally solid form and therefore would inherently prevent the accumulation of water; see column 4, lines 57-62."

Miller's stacked mats are not what is claimed, but "said flat sections" of parent Claim 1 which are treads without sidewalls. Thus, the Examiner errs in rejecting only one feature of the claimed combination rather than the combination in entirety including the

novel features of Claim 1 hereinbefore discussed.

Further more the Examiner errs in interpreting the Miller reference wherein the "generally solid form" is acknowledged by Miller to be a "*nearly* solid block"at col. 4, lines 59-61. The Examiner erroneously concludes that this "nearly solid block" would inherently prevent the accumulation of water, whereas as a matter of fact, the mis-represented Miller Fig. 4 configuration contains a large number of internal cavities caused by the different thicknesses of the tread and sidewall portions (not shown in Fig. 4) that would accumulate water in mosquito breeding beds if stored in the outside environment.

Accordingly applicant petitions reversal of this rejection ground with allowance of Claims 1 and 9.

Claims 2, 11 and 15

2. The method of Claim 1 further comprising the step of covering substantially all of the pallet loading platform area with said sections.

11. The method of Claim 1 further comprising the steps of transporting loaded pallets to store at a storage site in a compact configuration with pallets side-by-side and stacked on top upon one another.

15. The method defined in Claim 1 further comprising the step of compactly storing pallets loaded with said flat treaded strips at a selected outdoor storage site.

The Examiner concedes in the initial office action that Miller "does not disclose completely filling the pallet, storing the pallets outdoors or storing the pallets side by side and upon one another" and concludes obviousness without any evidence or reason such

as an allegation that Pignataro teaches that these steps would have been obvious.

The Examiner errs by not addressing the combinations defined as a whole including the interacting combination of features in parent Claim 1, but selecting only elements of the overall interacting combination which are concluded to be obvious in spite of concession of novelty.

Thus the Examiner has failed to exercise his duty of burden of proof of a *prima facie* case of obviousness.

Accordingly applicant petitions reversal and allowance of Claims 2, 11 and 15.

Claims 10 and 13

10. The method of Claim 1 further comprising the steps of cutting annular sidewall sections from said carcasses, stacking pluralities of annular sidewall sections in a plurality of piles upon said pallet platform and retaining the piles in place upon transportation of loaded pallets resisting lateral movement by strapping the piles to the pallet.

13. -- and stacking said flat treaded strips on said pallets in an interlocked self-supporting rubber-to-rubber configuration without supporting bolts or hardware by stacking a multiplicity of said treaded strips in a configuration that is adapted to resist lateral movement of the flat treaded strips during transport of the pallet by a fork lift truck.

Both these claims define features contrary to the Miller disclosure and Pignataro. Miller neither cuts annular sidewall sections from the carcasses or straps the sidewall sections to the pallet. Nor does Miller interlock flat tread strips to resist lateral movement without bolts or hardware.

The Examiner fails to address the interacting features of the entire claims 10 and

13 including Parent Claim 1 which are contrary to both the teachings of Miller, but which would destroy the identity of Miller as an inoperable teaching (see In re Gordon and Kramer, *supra*). He thus only rejects excerpted elements, and thus fails to establish a *prima facie* case of obviousness of the claims as a whole.

Accordingly applicant petitions reversal and allowance of Claims 10 and 13.

IV. THE EXAMINER'S DEFICIENCY IN BURDEN OF PROOF AND APPLICATION OF THE MILLER REFERENCE

Reversible error in the ruling of the Examiner that retained claims 1, 2, 9-11, 13 and 15 are obvious under 35 U.S.C. 103(a) has been established as a failure of the Examiner to exercise his burden of proof and thus merits allowance of these claims, which is respectfully petitioned.

It has been established that the interaction of the claimed limitations in these rejected combination claims is not found in either Miller or Pignataro taken singly or in combination, nor is there any teaching in Pignataro that Miller could be modified to provide the claimed methods of any one of these rejected claims.

It has been shown that Miller requires that the sidewalls must be attached to the tire treads to be operational to produce the article of manufacture desired by Miller, but that applicant claims *tire tread strips excluding sidewalls in each of the rejected claims* to directly depart from the teachings of Miller.

It has been shown that the disclosed Miller bundles have been misapplied by the

Examiner to selected claim elements rather than the interacting combination of elements in the claims as a whole and in inherently preventing the accumulation of water. The latter, as more extensively clarified hereinafter in Sec. (8)(v) II, is critical to applicant's unique objective (not in either reference) of removing mosquito breeding puddles in the bulk storage of reclaimed tire carcass rubber in the outside environment.

It has been established that the references do not contemplate the efficient bulk storage of rubber from tire carcasses, but have the unrelated objective of producing building elements from tire carcasses.

It is established by consideration of 35 U.S.C. 103(a) case law that the Examiner has failed to meet his burden of proof and improperly makes the primary Miller reference inoperative by modifications alleged to be obvious.

Accordingly it is petitioned that the Examiner be reversed in the rejection by allowance of Claims 1, 2, 9-11, 13 and 15.

(8)(v) OTHER ERRORS OF THE EXAMINER

V. MISINTERPRETATION OF THE MILLER REFERENCE

In the final rejection the Examiner erroneously interprets the Miller reference as follows: *Applicant also argues that Miller does not disclose the method step of preventing the accumulation of water in the strips. However, Miller clearly discloses stacking the tire mats to form a generally solid form and therefore would inherently prevent the accumulation of water; see column 4, lines 57-62.*

This is the first such rejection ground in the final rejection, and thus applicant had not been given the opportunity to traverse that rejection ground without the serious restrictions following final rejection. The Examiner has nevertheless now refused to consider the 37 CFR 1.132 declaration of applicant, as considered in more detail hereinafter.

Also the Examiner misapplies Miller by selecting separate elements without consideration of interaction of other elements in the combination claims rejected. In this respect he overlooks and gives no merit to three claimed material differences over Miller interacting in the rejected combination claims as discussed re: Claim 1 *supra*, namely: (a) the inexpensive and compact bulk storage of reclaimable tire carcass rubber, (b) with employment of flat tire tread strips exclusive of sidewalls, and (c) the rubber to rubber interfacing configuration of the tread strips in stacks to facilitate transportation on pallet platforms, therefore misapplying the primary Miller reference.

The Examiner's view that Miller discloses a solid body inherently preventing accumulation of water, fails to consider the many internal cavities of Millers bundled mats that have a propensity to accumulate water. With thicker treads and thinner sidewalls there is no way that the Miller banded mats could be solid enough to inherently prevent accumulation of water as the Examiner theorizes. With treads being thicker than sidewalls, the stacked mats of Miller create a large number of cavities that would accumulate water. Consider that Miller misrepresents the mat bundles shown in Figure 4 wherein the mat layers are not separated into thicker tread central portions and thinner

sidewalls extending therefrom to establish a myriad of cavities at the interface regions between the treads and the sidewalls

As a matter of recognized fact for automobile tire carcasses, tire tread thicknesses are 3/8 to ½ inch in thickness, whereas the sidewall thicknesses are 1/4 inch or less. Thus Miller's bundle of nine strips would for ½ inch thick treads be four and a half inches at the center tread region. But, at the outer edges of the sidewalls would be two and a quarter inch thick or less. Thus the bundles of Miller are misrepresented in the Drawings, in that the transition zones between the treads and outer edge of the sidewalls is omitted as well as the omission of 128 internal void cavities. Accordingly the Miller configurations could not inherently prevent accumulation of water when stored in an outside environment, as the Examiner alleges. Note that the void cavities lie between each two mat layers on opposite sides of the central tire tread portions. Thus in view of the greater thickness in the vicinity of the centered tire tread portion, and the much thinner ends of the bundled sidewall outer ends, there would be a significant droop from the centered tread height.

Accordingly the basis for the Examiner's rejection of claims under 35 U.S.C. 103(a) is erroneous as a matter of misapplying Miller as the primary reference which the Examiner requires to sustain his 35 U.S.C. rejection ground. Thus it is respectfully solicited that the 35 U.S.C.103(a) rejection of the Examiner be overruled and that Claims 1, 2, 9-11, 13, and 15 be allowed.

VI. THE EXAMINER'S OBJECTION TO CLAIMS 3-8, 12 & 16

In the Final Rejection of Oct. 30, 2002, the Examiner indicates the claims 3-8, 12 & 16 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening. In the (entered) Amendment of Dec, 9, 2002 these claims were so amended. Thus the Examiner reversibly errs.

Accordingly allowance of Claims 3-8, 12 and 16 is respectively solicited.

VII. REFUSAL TO CONSIDER THE 37 CFR 1.132 DECLARATION

35 U.S.C. 1.132 provides that declarations traversing the Examiner's rejections upon a mode or capability of operation attributed to a reference may be received.

The Examiner only in the Final Rejection and for the first time interprets Miller as follows: *Applicant also argues that Miller does not disclose the method step of preventing the accumulation of water in the strips. However, Miller clearly discloses stacking the tire mats to form a generally solid form and therefore would inherently prevent the accumulation of water, see col. 4, lines 57-62.*

Note that the first 35 U.S.C. 103(a) rejection ground of retained Claims 1 and 9 is in the Final Rejection of Oct. 20, 2002. Claim 9 follows:

9. (Amended) The method of Claim 1 further comprising the step of piling said flat sections into stacks that avoid accumulation of water when stored outside in the environment.

Therefore the responses after the Final Rejection was the first time applicant was

able to respond to the 103 obviousness rejection based upon the Examiner's view that the stacked mats of Miller inherently prevents accumulation of water in the strips. The Declaration was submitted to address this issue.

Thus the Examiner errs in rejecting the declaration because it is not directed to issues which were newly raised by the Examiner in the final rejection. Accordingly entry and consideration of the Declaration as evidence of non-obviousness by this Honorable Board is respectfully solicited.

The declaration, which is directed solely to the new issue of inherent prevention of the accumulation of water by Miller sets forth by applicant's employee who worked with the reclaiming of abandoned tire carcasses and producing marketable products therefrom sets forth facts upon which the traversal disagreement with the Examiner's interpretation of Miller is based.

Material to applicants claims is the compact rubber-to-rubber interfacing configurations. The sketch in the declaration illustrates that this is not the case in Miller wherein the cavities *x* appear because of the diverse thicknesses of tire treads and sidewalls at the intersection of the two. Those cavities are voids that have the propensity of accumulating water to introduce mosquito breeding beds.

VIII. SUMMARIZATION AND PETITION

Retained claims 1-13, 15 and 16 are presented for allowance upon reversal of the Examiner.

Claims 3-8, 12 and 16 were indicated allowable with amendments putting them in independent form. These amendments were made by applicant. However the Examiner has maintained the objection to these claims in his latest Advisory Action of Jan.. 8, 2003. Thus allowance of these claims is in order and is thus petitioned.

The hereinbefore set forth traversal of the rejection grounds under 35 U.S.C. 103(a) of Claims 1, 2, 9-11, 13 and 15 has shown reversible error in the rejection of each of these claims. Accordingly applicant petitions reversal of the Examiner and allowance of each of these claims.

As a matter of perspective over the cited art applicant has made a significant breakthrough in the outside efficiency of storage of reclaimable tire carcass rubber in an manner unexpectedly solving the long existing problem in tire storage of creating water beds in which mosquitos breed. That breakthrough certainly was not made obvious by Miller or Pignataro either singly or in combination.

Thus allowance of the rejected claims is merited and petitioned.

(9) Appendix

The claims 1-13, 15 and 16 retained and herein repealed are set forth in the accompanying appendix.

Respectfully Submitted, Jan. 27 , 2003

Laurence R. Brown

Laurence R. Brown, Counsel of Record

Enc.$160.00 Appeal Brief fee

APPENDIX

1. The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products, comprising in combination the steps of: cutting reclaimed tire carcasses into sets of substantially flat storable sections of tire tread strips excluding sidewalls, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, and stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space.

2. The method of Claim 1 further comprising the step of covering substantially all of the pallet loading platform area with said sections.

3. The method of Claim 1 further comprising the steps of cutting flat rectangular tread strips from the carcasses of a length greater than the length or width dimension of the platform areas and folding the flat tread strips into abutted stacked configurations having a length footprint substantially that of one of the platform dimensions.

4. The method of Claim 3 further comprising the step of abutting said stacked configurations side-by-side to substantially cover the loading platform areas.

5. The method of Claim 3 further comprising the step of interlocking the tread strips in a rubber-to-rubber self-supporting configuration for stable transport of loaded pallets.

6. The method of Claim 5 comprising the more detailed step of disposing two adjacent folded strips of the stacked configuration for frictional contact between the two strips that tends to retard lateral movement of the strips.

7. The method of Claim 6 comprising the more detailed step of contacting one of the two adjacent folded strips in mutual rubber-to-rubber contact over half its length.

8. The method of claim 6 comprising the more detailed step of contacting adjacent folded strips in rubber-to-rubber contact over substantially their entire length.

9. The method of Claim 1 further comprising the step of piling said flat sections into stacks that avoid accumulation of water when stored outside in the environment.

10. The method of Claim 1 further comprising the steps of cutting annular sidewall sections from said carcasses, stacking pluralities of said annular sidewall sections in a plurality of piles upon said pallet platform, and retaining the piles in place upon transportation of loaded pallets resisting lateral movement by strapping the piles to the pallet.

11. The method of Claim 1 further comprising the steps of transporting loaded pallets to store at a storage site in a compact configuration with pallets side-by-side and stacked upon one another.

12. The method of Claim 1 further comprising the steps of cutting the flat storable sections from the carcass tread of a length greater than one pallet dimension to be placed lengthwise along that pallet dimension and folding over said sections to interlock adjacent sections in the stacks by frictional rubber-to-rubber contact between the tread and two adjacent sections.

13. The method of Claim 1 further comprising the steps of:

removing opposing sidewalls from reclaimed tire carcasses to produce a treaded annular portion of the carcasses,

cutting the annular portion to form flat treaded strips of a length and width that may be stacked rubber-to-rubber upon the one of the pallet's dimensions without accumulating water,

configuring said pallets for transport by a fork lift truck, and

stacking said flat treaded strips on said pallets in an interlocked self-supporting rubber-to-rubber configuration without supporting bolts or hardware by stacking a multiplicity of said treaded strips in a configuration that is adapted to resist lateral movement of the flat treaded strips during transport of the pallet by a fork lift truck.

15. The method defined in Claim 14 further comprising the step of compactly storing pallets loaded with said flat treaded strips at a selected outdoor storage site.

16. The method of Claim 1 further comprising the more detailed steps of: configuring the flat treaded strips longitudinal in shape to have a length compatible with folding and stacking the treaded strips aligned upon one of said length or width dimensions of said pallets in a folded U-shaped configuration with one respective folded strip end trip alternately interlocked between the two ends of an adjacent strip to substantially fill the inner end of the U-shaped configuration, and stacking the interlocked flat treaded strips upon the pallets with the closed end of a plurality of the U-shaped configurations alternating near opposite edges of the pallets.